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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/592,031

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EXAMINER

SAAD, ERIN BARRY

ART UNIT

PAPER NUMBER

1793

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/592,031	Applicant(s) DZIALAS ET AL.	
	Examiner ERIN B. SAAD	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-28 is/are pending in the application.
- 4a) Of the above claim(s) 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 16-18, 25-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/7/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of invention I in the reply filed on 6/8/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10-15 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,053,233 (from IDS dated 9/7/2006).

Regarding claim 10, '233 discloses a rotary friction welding machine (figure 4) for joining or connecting components, with a first rotating spindle 67a and a second non-rotating spindle 67b, wherein a first component of the components being connected to one another is capable of being positioned on the first spindle and a second component of the components being connected to one another is positioned on the second spindle, wherein several flywheel mass bodies 57 are positioned on the rotary friction welding machine, wherein the flywheel mass bodies cooperate with the first rotating spindle

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such that at least one of the flywheel mass bodies is capable of being brought out of operating engagement or into operating engagement with the first rotating spindle, and wherein flywheel mass bodies that are in operating engagement with the first rotating spindle and flywheel mass bodies that are out of operating engagement with the first rotating spindle capable of being positioned on the rotary friction welding machine (figure 4 and page 2 column1 line 15 to column 2 line 125 and page 3 column 1 line 19 to column 2 line 81).

As per MPEP 2114 relating to Apparatus and Article claims – Functional Language: While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). As the references and the claimed *APARATUS* are patentably indistinguishable, the apparatus of the prior art is reasonable expected to be able to perform the claimed functionality (i.e. *LIMITATION*).

Regarding claim 11, '233 discloses that several flywheel mass bodies 57 are allocated to the first rotating spindle such that the flywheel mass bodies are capable when in operating engagement with the first spindle rotate jointly with the spindle and when out of operating engagement with the first spindle are stationary as compared with the spindle (figure 4 and page 2 column 2 lines 99-125 and page 3 column 1 line 19 to column 2 line 81)).

Regarding claim 12, '233 discloses that at least one of the flywheel mass bodies is rigidly connected to the first rotating spindle, while the other flywheel mass bodies are

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rotatably mounted on the spindle in such a way that the other flywheel mass bodies are capable of being selectively coupleable to and uncoupleable from every flywheel mass body that is rigidly connected to the first spindle (figure 4 and page 2 column 2 lines 99-125 and page 3 column 1 line 19 to column 2 line 81).

Regarding claims 13 and 22, '233 discloses that the several flywheel mass bodies are allocated to a flywheel mass shaft/torque tube 56, wherein the flywheel mass shaft is coupled to the first rotating spindle via a transmission gear/pulley 58 (figure 4, page 3 column 1 lines 37-65).

Regarding claim 14, the flywheel mass bodies of '233 in operating engagement with the first spindle are capable of rotating jointly with the flywheel mass shaft and when out of operating engagement with the first spindle are stationary as compared with the flywheel mass shaft. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114).

Regarding claim 15, '233 discloses that at least one of the flywheel mass bodies is rigidly connected to the flywheel mass shaft, while every other flywheel mass body is rotatably mounted on the flywheel mass shaft in such a way that the other flywheel mass bodies are capable of being selectively coupleable to and uncoupleable from the flywheel mass body that is rigidly connected to the flywheel mass shaft (page 3 column 1 lines 37-65).

Regarding claim 19, '233 discloses an apparatus for rotary friction welding, comprising a rotary friction welding machine, including: a first rotatable spindle 67a; a

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second non-rotatable spindle 67b; and a plurality of flywheel mass bodies 57; wherein the plurality of flywheel mass bodies are positioned on the rotary friction welding machine, and wherein at least one of the plurality of flywheel mass bodies is capable of being operatively engageable and dis-engageable with the first rotatable spindle (figure 4 and page 2 column1 line 15 to column 2 line 125 and page 3 column 1 line 19 to column 2 line 81).

As per MPEP 2114 relating to Apparatus and Article claims – Functional Language: While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). As the references and the claimed *APARATUS* are patentably indistinguishable, the apparatus of the prior art is reasonable expected to be able to perform the claimed functionality (i.e. *LIMITATION*).

Regarding claim 20, '233 would be capable of when the at least one of the plurality of flywheel mass bodies is operatively engaged with the first rotatable spindle the at least one of the plurality of flywheel mass bodies is rotatable jointly with the first rotatable spindle and wherein when the at least one of the plurality of flywheel mass bodies is operatively dis-engaged with the first rotatable spindle the at least one of the plurality of flywheel mass bodies is not jointly rotatable with the first rotatable spindle. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114).

Regarding claim 21, '233 discloses that at least one of the flywheel mass bodies is rigidly connected to the first rotatable spindle (figure 4 and page 2 column 2 lines 99-125 and page 3 column 1 line 19 to column 2 line 81), and wherein the at least one of the plurality of flywheel mass bodies is capable of being operatively engageable and dis-engageable with the first rotatable spindle is selectively coupleable to and uncoupleable from the at least one of the flywheel mass bodies that is rigidly connected to the first rotatable spindle. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114).

Regarding claim 23, '233 discloses that at least one of the plurality of flywheel mass bodies is operatively engaged with the first rotatable spindle the at least one of the plurality of flywheel mass bodies is rotatable jointly with the flywheel mass shaft and wherein when the at least one of the plurality of flywheel mass bodies is capable of being operatively dis-engaged with the first rotatable spindle the at least one of the plurality of flywheel mass bodies is not rotatable with the flywheel mass shaft (figure 4 and page 2 column 2 lines 99-125 and page 3 column 1 line 19 to column 2 line 81). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114).

Regarding claim 24, '233 discloses that at least one of the flywheel mass bodies is rigidly connected to the flywheel mass shaft (figure 4 and page 2 column 2 lines 99-125 and page 3 column 1 line 19 to column 2 line 81), and wherein the at least one of

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the plurality of flywheel mass bodies that is capable of being operatively engageable and dis-engageable with the first rotatable spindle is selectively coupleable to and uncoupleable from the at least one of the flywheel mass bodies that is rigidly connected to the flywheel mass shaft. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114).

Allowable Subject Matter

4. Claims 16-18 and 25-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 16 and 25, the prior art of record failed to teach or suggest all the limitations of claims 16 and 25 including having the flywheel mass bodies moveable back and forth between two magazine halves. '233 does not disclose magazine halves. It would not have been obvious to add magazine halves capable of having the flywheel mass bodies moveable back and forth between them such that the mass bodies are in operating engagement with the first spindle in a position that is inserted into the first magazine half and out of operating engagement with the first spindle in a position that is inserted into the second magazine half.

Claims 17-18 and 26 are dependent on claims 16 and 25.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIN B. SAAD whose telephone number is (571)270-3634. The examiner can normally be reached on Monday through Thursday from 8am-5pm Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on (571) 272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. B. S./
Examiner, Art Unit 1793
8/12/2009

/Kevin P. Kerns/
Primary Examiner, Art Unit 1793